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| 09/944,590 | 09/04/2001 | Yuji Sezai | 110537 | 1660 |

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| EXAMINER |
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KOSLOW, CAROL M

| ART UNIT | PAPER NUMBER |
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1755

DATE MAILED: 04/11/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|-------------------------------|---------------------|
| | 09/944,590 | SEZAI ET AL. |
| | Examiner C. Melissa Koslow | Art Unit 1755 |

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 March 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 04 September 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) Other: _____

Upon further consultation with the Primary Examiners of classes 375 and 336, it has been determined that the phrase "for an xDSL modem transformer" does not impart any specific structure to the magnetic core of claims 5-10. Accordingly, Groups I and II should have been a single group. Therefore, since applicants have elected Group II, which should have included group I; claims 1-10 will be examined.

Applicant's election with traverse of Group II, claims 1-10 is acknowledged. The traversal is on the ground that there is no serious burden to search all the claims and that the search for claims 1-10 would encompass the search for claims 11 and 12. This is not found persuasive because a serious burden on the examiner is *prima facie* shown by separate classification and applicants' arguments rebutting this showing are not convincing since the search for a composition and a core having an undefined structure does not require a search in class 336 or 375.

The requirement is still deemed proper and is therefore made FINAL.

The references in the Information Disclosure Statement of 4 September 2001 were considered with respect to the provided English abstracts.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent 6,423,243.

Example 1 of this reference teaches a magnetic core having a main component comprised of 24 mol% MnO, 23 mol% ZnO and 53 mol% Fe₂O₃. The claimed core and composition clearly read upon that those taught.

Claims 1, 2, 5-7 and 10 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent 6,217,789.

This reference teaches a magnetic core having a main component comprised of 22-25 mol% MnO, 22-25 mol% ZnO and the remainder is Fe₂O₃. This composition falls within composition of claims 1 and 6. Examples 1 and 2 teach cores having the compositions given in tables 1 and 2. These compositions fall within the compositions of claims 1, 2, 6 and 7. Samples 1-3 and 16-20 teach compositions that fall within the compositions of claims 1, 2, 5-7 and 10. The claimed core and composition clearly read upon that those taught.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 10-335130.

The abstract for this reference teaches a Mn-Zn ferrite having a main component comprised of 20-30 mol% MnO, 10-35 mol% ZnO and the remainder is Fe_2O_3 . The table on page 4 teaches ferrite compositions having a main component comprised of 25 mol% MnO, 23 mol% ZnO and the remainder is Fe_2O_3 , which falls within the composition of claims 1 and 2. The claimed composition clearly reads upon that taught.

Claims 1, 2, 3 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 6-263447.

The abstract for this reference teaches a Mn-Zn ferrite having a main component comprised of 52.5-53 mol% Fe_2O_3 , 22-25 mol% ZnO and the remainder is MnO, which is 22-25.5 mol%. The composition of examples 3, 4 and 7-15 in the table on page 3 and in paragraph [0007] all fall within the composition of claim 1. The composition of examples 7-15 in the table on page 3 all fall within the composition of claim 2. The composition of examples 7 and 12 in the table on page 3 all fall within the composition of claim 3. The composition of example 9 in the table on page 3 all fall within the composition of claim 5. The claimed composition clearly reads upon that taught.

Claims 1, 2, 6 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Takeda.

This reference teaches a magnetic core having a main component comprised of 53.6-54.4 mol% Fe_2O_3 , 13.0-13.5 mol% ZnO and the remainder is MnO, which is 32.3-33.3 mol%. The taught composition of Takeda falls within that of claims 1 and 6. The composition of the sample cores 1, 3, 5, 6 and 8-23 all fall within that of claims 1, 2, 6 and 7. The claimed core and composition clearly read upon that those taught.

Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 11-302069.

This reference teaches a magnetic core having a main component comprised of 51-54 mol% Fe_2O_3 , 20-25 mol% ZnO and the remainder is MnO , which is 20-29 mol%. The composition of example 1 of JP 11-302069, which is 23.8 mol% MnO , 24 mol% ZnO and 52.2 mol% Fe_2O_3 , falls within the composition of claims 1-3 and 6-8. The claimed core and composition clearly read upon that those taught.

Claims 1, 2, 5-7 and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 10-72217.

This reference teaches a magnetic core having a main component comprised of 52.5-53 mol% Fe_2O_3 , 22-25 mol% ZnO and the remainder is MnO , which is 22-25.5 mol%. This composition falls within the compositions of claims 1 and 6. The compositions of the cores in examples 7-15 in table 1 fall within the composition of claims 2 and 7. The composition of the cores in example 9 in table 1 falls within the composition of claims 5 and 10. The claimed core and composition clearly read upon that those taught.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda.

As stated above, this reference teaches a magnetic core having a main component comprised of 53.6-54.4 mol% Fe_2O_3 , 13.0-13.5 mol% ZnO and the remainder is MnO , which is 32.3-33.3 mol%. The taught ranges overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed cores and compositions.

Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-263,447.

As stated above, this reference teaches a Mn-Zn ferrite having a main component comprised of 52.5-53 mol% Fe_2O_3 , 22-25 mol% ZnO and the remainder is MnO , which is 22-25.5 mol%. The taught ranges overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed compositions.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-335130.

As stated above, this reference teaches a Mn-Zn ferrite having a main component comprised of 20-30 mol% MnO , 10-35 mol% ZnO and the remainder is Fe_2O_3 , which is 35-70 mol%. The taught ranges overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re*

Fields 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed compositions.

Claims 1-3, 5-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-72217.

As stated above, this reference teaches a magnetic core having a main component comprised of 52.5-53 mol% Fe_2O_3 , 22-25 mol% ZnO and the remainder is MnO , which is 22-25.5 mol%. The taught ranges overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed cores and compositions.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-302069.

As stated above, this reference teaches a magnetic core having a main component comprised of 51-54 mol% Fe_2O_3 , 20-25 mol% ZnO and the remainder is MnO , which is 20-29 mol%. The taught ranges overlap the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The reference suggests the claimed cores and compositions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (703) 308-3817. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (703) 308-3823.

The fax number for Amendments filed under 37 CFR 1.116 or After Final communications is (703) 872-9311. The fax number for all other official communications is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661 or (703) 308-0662.

cmk
April 10, 2003


C. Melissa Koslow
Primary Examiner
Tech. Center 1700